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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|---------------------|------------------|
| 10/672,310 | 09/25/2003 | Tom J. Foegen | 3729.48US01 | 5741 |
| 24113 7590 10/06/2008 PATTERSON, THUENTE, SKAAR & CHRISTENSEN, P.A. 4800 IDS CENTER 80 SOUTH 8TH STREET MINNEAPOLIS, MN 55402-2100 | | | | |
| EXAMINER NGUYEN, THUY-VI THI | | | | |
| ART UNIT | | PAPER NUMBER | | |
| 3689 | | | | |
| MAIL DATE | | DELIVERY MODE | | |
| 10/06/2008 | | PAPER | | |

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/672,310

Applicant(s)

FOEGEN ET AL.

Examiner

THUY VI NGUYEN

Art Unit

3689

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 September 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-43 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-43 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/CDC)
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date: _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date: _____

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-34, 38-39, drawn to method and system and computer readable medium having instruction for performing the method of pre-planning printed products between a print vendor's server and a client's computer networked to the print vendor's server; classified in class 705, subclass 01.
 - II. Claims 35-37, drawn to a method of managing plan order information in a computer system having a graphical user interface, classified in class 705, subclass 01.
 - III. Claims 40-43, drawn a set of application program interfaces embodied on a computer-readable medium for execution on a compute in conjunction with an application program that specifies a client's print order to a print vendor, classified in class 705, subclass 01.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions in **Groups I and II** are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different designs, modes of operation, and effects (MPEP § 802.01 and § 806.06). In the instant

case, the invention of group I drawn to method and system and computer readable medium having instruction for performing the method of pre-planning printed products between a print vendor's server and a client's computer networked to the print vendor's server, while invention of group II is directed to a method of managing plan order information in a computer system having a graphical user interface which deals with retrieving, displaying, modifying a set of menu items and a selection signal.

Because these inventions are independent or distinct for the reasons given above, because the search required for Group I, is not necessarily required for Group II due to their different scope and subject, and vice versa, restriction for examination purposes as indicated is proper since it's a serious burden for the examiner to examine all of these amended claims.

3. Inventions in **Groups I and III** are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different designs, modes of operation, and effects (MPEP § 802.01 and § 806.06). In the instant case, the invention of group I is directed to method and system and computer readable medium having instruction for performing the method of pre-planning printed products between a print vendor's server and a client's computer networked to the print vendor's server, while invention of group III is directed to a set of application program interfaces embodied on a computer-readable medium for execution on a compute in conjunction with an application program that specifies a client's print order to a print vendor.

Because these inventions are independent or distinct for the reasons given above, because the search required for Group I, is not necessarily required for Group III due to their different scope and subject, and vice versa, restriction for examination purposes as indicated is proper since it's a serious burden for the examiner to examine all of these amended claims.

4. Inventions in **Groups II and III** are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different designs, modes of operation, and effects (MPEP § 802.01 and § 806.06). In the instant case, the invention of group II is directed to a method of managing plan order information in a computer system having a graphical user interface which deals with retrieving, displaying, modifying a set of menu items and a selection signal, while invention of group III is directed to a set of application program interfaces embodied on a computer-readable medium for execution on a compute in conjunction with an application program that specifies a client's print order to a print vendor.

Because these inventions are independent or distinct for the reasons given above, because the search required for Group II, is not necessarily required for Group III due to their different scope and subject, and vice versa, restriction for examination purposes as indicated is proper since it's a serious burden for the examiner to examine all of these amended claims.

Note: In the instant case, the different inventions have different modes of operation and thus producing different effects and are not capable of use together to

achieve their respective scopes even though there may be one or two common steps. Also, the limitations in the preamble is considered as "capable of" carrying out the scope of the claimed invention and the method steps are considered essential to carry out the invention.

5. Applicant is advised that the reply to this requirement to be complete must include an election of the invention, either group I or II or III, to be examined even though the requirement be traversed (37 CFR 1.143).

Conclusions

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thuy-Vi Nguyen whose telephone number is 571-270-1614. The examiner can normally be reached on Monday through Thursday from 8:30 A.M to 6:00 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Janice Mooneyham can be reached on 571-272-6805. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should

you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/T. N./

Examiner, Art Unit 3689

/Janice A. Mooneyham/

Supervisory Patent Examiner, Art Unit 3689